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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,912	08/02/2001	Allen E. Milewski	02685/5883	4825

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EXAMINER

MOFIZ, APU M

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,912

Applicant(s)

MILEWSKI ET AL.

Examiner

Apu M Mofiz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001 and December 26, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Apu Mofiz
Apu Mofiz
Patent Examiner
Technology Center 2100

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. Applicant's Pre-Amendment dated December 26, 2001 has been received.

Priority

2. This application discloses and claims only subject matter disclosed in prior Application No. 09/041,433, filed on 03/12/1998, now US Patent no.6,289,346, and names an inventor or inventors named in the prior application. This application therefore constitutes a continuation or division in accordance to 35 U.S.C. 120 and 37 CFR 1.78. Applicant's desire to obtain the benefit of the filing date of the prior application has been granted.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,289,346. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

With regards to claim 1 of the present application, claim 1 of the cited patent recites (column 8, lines 35-52) the following:

- (a) A method for searching for an archived version of a broadcasted item of interest comprising the steps of:
- (b) displaying said broadcasted item of interest on a broadcast television network to a viewer;
- (c) querying a data network to determine whether said broadcast item of interest is archived;
- (d) providing identification information for said broadcasted item of interest and the viewer to a data network server;
- (e) identifying an archival address for said archived version of said broadcasted item of interest, said archived version of said broadcasted item of interest substantially replicating said broadcasted item of interest, and said archived version of said broadcasted item of interest being stored on a data network;
- (f) notifying the viewer of said archival address; and transmitting said archival address for said archived version of said broadcasted item of interest to the viewer.

Claim 1 of the instant application omits the expression -- version of a broadcasted-- from step 'a' as shown in underlined italic to yield the current step. It replaces the expression -- displaying said broadcasted-- by --viewing an-- and --broadcast television

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network-- by --first medium-- in step 'b' to yield the current step. It further omits the step 'c'. It omits ---broadcasted--- and --data-- from step 'd' above to yield the current step. It omits --broadcasted-- and --substantially... archived... item of interest-- and replaces --data network-- by ---second medium-- to yield to current step. It would have been obvious to one of ordinary skill in the art of searching at the time the invention was made to modify the cited steps as indicated above since the omission or addition of the cited limitations would have not changed the process according to which an archived item of interest are being searched in an archival (i.e. a file repository, database etc.). It has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

As to claim 2 of the present application, claim 2 of cited patent recites (column 8, lines 53-55) the following:

2. The method of claim 1 further comprising the step of bookmarking said archival address on a personal computer of the viewer.

As to claim 3 of the present application, claim 3 of cited patent recites (column 8, lines 56-59) the following:

3. The method of claim 1 wherein said step of providing identification information for said broadcasted item of interest includes providing information specifying a particular segment of said broadcasted item of interest.

As to claim 4 of the present application, claim 4 of cited patent recites (column 8, lines 59-63) the following:

4. The method of claim 3 wherein said information specifying a particular segment of said broadcasted item of interest is a time of viewing said particular segment.

As to claim 5 of the present application, claim 5 of cited patent recites (column 8, lines 62-65) the following:

5. The method of claim 1 wherein said step of providing identification information for said broadcasted item of interest to said data network server comprises the step of sending an electronic mail message to said data network server.

As to claim 6 of the present application, claim 6 of cited patent recites (column 8, lines 66-67; column 9, lines 1-3) the following:

6. The method of claim 1 wherein said step of providing identification information for said broadcasted item of interest to said data network server comprises the step of orally communicating said identification information to said data network server.

As to claim 7 of the present application, claim 7 of cited patent recites (column 9, lines 4-5) the following:

7. The method of claim 1 further comprising the step of storing said archival address on a web page.

As to claim 8 of the present application, claim 8 of cited patent recites (column 9, lines 6-7) the following:

8. The method of claim 1 further comprising the step of storing said archival address on a personal computer.

As to claim 9 of the present application, claim 9 of cited patent recites (column 9, lines 8-10) the following:

9. The method of claim 7 further comprising the step of providing information associated with said archival address to said web page.

As to claim 10 of the present application, claim 1 (step 'c' of claim 1, which was omitted in claim 1 of the present application) of the cited patent recites (column 8, lines 40-41) the following:

(c) querying a data network to determine whether said broadcast item of interest is archived;

Claim 10 of the instant application replaces the expression -- querying a data network to determine whether said broadcast item of interest is archived-- by ---determining whether said item of interest is archived on said second medium-- to yield the current step. It would have been obvious to one of ordinary skill in the art of searching at the time the invention was made to modify the cited steps as indicated above since the omission or addition of the cited limitations would have not changed the process according to which an archived item of interest are being searched in an archival (i.e. a file repository, database etc.). It has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

As to claim 11 of the present application, claim 10 of cited patent recites (column 9, lines 11-12) the following:

10. The method of claim 1 wherein said archival address for said archived version of said item of interest is a URL.

As to claim 12 of the present application, claim 11 of the cited patent recites (column 9, lines 13-34) the following:

11. An apparatus for bookmarking an archived version of a broadcasted item of interest comprising:

(a) a database resident in a data network server, said database containing information related to availability of said archived version of said broadcasted item of interest stored on an archiving data network, said archived version of said broadcasted item of interest substantially replicating said broadcasted item of interest, said network server adapted to search said database determining whether said broadcast item of interest is archived and notifying the viewer of said archival address;

(b) a data network interface, said data network interface contained in said data network server and providing interconnection to the archiving data network; and

(c) a user input device, said user input device communicating with said data network server to provide identification information for the broadcasted item of interest and the viewer of the broadcasted item of interest wherein the viewer is viewing the broadcasted item of interest on a broadcast medium separate from said archiving data network.

Claim 12 of the instant application omits the expression --data-- and --broadcasted-- and --broadcast-- from step 'a', 'b' and 'c' as shown in underlined italic to yield the current step. It omits the expression --said archived version of said broadcasted-- and --said archived version of said broadcasted item of interest substantially replicating said

broadcasted item of interest, said network server adapted to search said database determining whether said broadcast item of interest is archived and notifying the viewer of said archival address-- from step 'a' to yield the current step. It would have been obvious to one of ordinary skill in the art of searching at the time the invention was made to modify the cited steps as indicated above since the omission or addition of the cited limitations would have not changed the process according to which an archived item of interest are being searched in an archival (i.e. a file repository, database etc.). It has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

As to claim 13 of the present application, claim 12 of cited patent recites (column 9, lines 35-36) the following:

12. The apparatus of claim 11 wherein said user input device is a two-way pager.

As to claim 14 of the present application, claim 13 of cited patent recites (column 9, lines 37-38) the following:

13. The apparatus of claim 12 wherein said data network server includes voice recognition software.

As to claim 15 of the present application, claim 14 of cited patent recites (column 9, lines 39-40) the following:

14. The apparatus of claim 13 wherein said user input device is a telephone.

As to claim 16 of the present application, claim 15 of the cited patent recites
(column 9, lines 41-57) the following:

15. A method for bookmarking an archived version of a broadcast program of interest comprising the steps of:

(a) receiving, at a data network server, identification information for a broadcast program of interest broadcasted on a broadcast network, said identification information including information specifying the broadcast network on which said broadcast program of interest was broadcasted and specifying a time of broadcast of said broadcast program of interest;

(b) querying a database to determine whether said broadcast program of interest is archived; determining an archival address for said archived version of said broadcast program of interest, said archived version substantially replicating said broadcast program of interest and said archived version stored on an archiving data network; and

(c) bookmarking said archival address.

Claim 16 of the instant application omits the expression --data-- and --broadcasted on a broadcast network-- and --broadcast-- from step 'a' as shown in underlined italic to yield the current step. It omits the expression --querying a database to determine whether said broadcast program of interest is archived;-- and --said archived version substantially replicating said broadcast program of interest and said archived version stored on an archiving data network;-- from step 'b' to yield the current step. It would have been obvious to one of ordinary skill in the art of searching at the time the invention was made to modify the cited steps as indicated above since the omission or addition of the cited limitations would have not changed the process according to which

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an archived item of interest are being searched in an archival (i.e. a file repository, database etc.). It has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

As to claim 17 of the present application, claim 16 of cited patent recites (column 9, lines 58-60) the following:

16. The method of claim 15 wherein said step of bookmarking said archival address comprises the step of storing said archival address on a personal computer.

As to claim 18 of the present application, claim 17 of cited patent recites (column 9, lines 61-63) the following:

17. The method of claim 15 wherein said step of bookmarking said archival address comprises the step of storing said archival address on a web page.

As to claim 19 of the present application, claim 18 of cited patent recites (column 10, lines 1-5) the following:

18. The method of claim 15 wherein said step of receiving identification information for said broadcast program of interest at said data network server comprises the step of receiving an electronic mail message at said data network server.

As to claim 20 of the present application, claim 19 of cited patent recites (column 10, lines 6-10) the following:

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19. The method of claim 15 wherein said step of receiving identification information for said broadcast program of interest at said data network server comprises the step of orally receiving said identification information at said data network server.

As to claim 21 of the present application, claim 20 of cited patent recites (column 10, lines 11-16) the following:

20. The method of claim 15 wherein said information specifying said time of broadcast of said broadcast program of interest identifies a particular segment of said broadcast program of interest and said archival address is associated with said particular segment of said broadcast program of interest.

As to claim 22 of the present application, claim 21 of cited patent recites (column 10, lines 17-20) the following:

21. The method of claim 16 further comprising the step of periodically accessing a database contained in said data network server to determine when said broadcast program of interest has been archived.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4,7-9,11-12,16-18 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al. (U.S. Patent No. 5,907,322 and Kelly hereinafter).

As to claim 1, Kelly teaches a method for searching for an archived (i.e. "Database 40 comprises information compiled from various sources, such as TV advertisements schedules 50 associated with various shows, TV show schedules 52, TV advertisers websites 62 and other websites topically related to broadcast content 64") (Examiner asserts that the database/database server on the network/internet contains information about archived/stored various TV shows at the broadcasters websites, which stores/archives their shows/information in their websites) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **comprising the steps of: viewing an item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **on a first medium** (i.e. the TV) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **by a viewer** (Fig.1; col 2, lines 35-67; col 3, lines 1-28); **providing identification information** (i.e. "activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory" ... "When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-line service 60 to a central database 40.") (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **for said item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **and the viewer** (i.e. the viewer identification information) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **to a network server** (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67;

col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28); **identifying** (i.e. the central database identifies the bookmark/URL of the TV event, which matches with the user provided identifying information) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **an archival address** (i.e. *"bookmarks associated with the broadcast event"* or URL) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **for an archived version** (i.e. the stored events/event related information, which is maintained by the broadcaster in their websites/or any other form of storage and is not the part of applicant's invention or Kelly's system) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **of said item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28), **said archived version** (i.e. the stored events/event related data etc.) **of said item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **being stored on a second medium** (i.e. they are stored in the broadcaster maintained storages e.g. websites where a website is essentially connected to a database or other forms of storage) (Fig.1; col 2, lines 35-67; col 3, lines 1-28); **and transmitting said archival address** (i.e. transmitting the bookmark or the URL of the broadcaster's websites to the viewer) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **for said archived** (i.e. stored) **version of said item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **to the viewer** (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 2, Kelly teaches the step of bookmarking said archival address on a personal computer of the viewer (i.e. *"Database 40 then generates a custom list of data for the user which indicates bookmarks associated with the broadcast event. For example this list of data could take the form, but not limited to, a World Wide Web (www) page on the internet."*... *"network access device 21 such as a set-top box comprising a computer system coupled to a conventional TV tuner 34, or a specialized TV having computer processing capability (i.e. a PCTV), both having conventional network connection capabilities or other means for*

on-line access to the internet or other networks 60. ") (Examiner asserts that a user sitting at a PCTV can receive bookmark information/URL/archival address from the network database server and bookmark the websites using a generic conventional web browser) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 3, Kelly teaches the step of providing identification information (i.e. the viewer provided identification information) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) for said item of interest includes providing information specifying a particular portion (i.e. a particular date, time, channel of the broadcasted event) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) of said item of interest (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 4, Kelly teaches that the said information (i.e. the viewer provided identifying information) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) specifying a particular portion of said item of interest (i.e. the broadcasted event) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) is a time (i.e. a particular date, time, channel of the broadcasted event) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) when viewing said particular portion (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 7, Kelly teaches the step of storing said archival address on a web page (i.e. "Database 40 then generates a custom list of data for the user which indicates bookmarks associated with the broadcast event. For example this list of data could take the form, but not limited to, a World Wide Web (www) page on the internet."... "network access device 21 such as a set-top box comprising a computer system coupled to a conventional TV tuner 34, or a specialized TV having computer processing capability (i.e. a PCTV), both having conventional network connection capabilities or other means for on-line access to the internet or other networks 60.") (Examiner asserts that a user sitting at a PCTV can receive bookmark information/URL/archival

address from the network database server and bookmark the websites using a generic conventional web browser) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 8, Kelly teaches the step of storing said archival address on a personal computer (i.e. *"Database 40 then generates a custom list of data for the user which indicates bookmarks associated with the broadcast event. For example this list of data could take the form, but not limited to, a World Wide Web (www) page on the internet."...* *"network access device 21 such as a set-top box comprising a computer system coupled to a conventional TV tuner 34, or a specialized TV having computer processing capability (i.e. a PCTV), both having conventional network connection capabilities or other means for on-line access to the internet or other networks 60."*) (Examiner asserts that a user sitting at a PCTV can receive bookmark information/URL/archival address/or any other information related to the event from the network database server and bookmark the websites using a generic conventional web browser; the archival address/bookmark can be stored in a web page also to be viewed by the viewer) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 9, Kelly teaches the step of providing information associated with said archival address to said web page (i.e. *"Database 40 then generates a custom list of data for the user which indicates bookmarks associated with the broadcast event. For example this list of data could take the form, but not limited to, a World Wide Web (www) page on the internet."...* *"network access device 21 such as a set-top box comprising a computer system coupled to a conventional TV tuner 34, or a specialized TV having computer processing capability (i.e. a PCTV), both having conventional network connection capabilities or other means for on-line access to the internet or other networks 60."*) (Examiner asserts that a user sitting at a PCTV can receive bookmark information/URL/archival address/or any other information related to the event from the network database server and bookmark the websites using a generic conventional web browser; the archival address/bookmark can be stored in a web page also to be viewed by the viewer) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 11, Kelly teaches that the archival address (i.e. the bookmark/URL) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) for said archived version of said item (i.e. the stored events/shows/programs/program associated information at the broadcasters web sites) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) of interest is a URL (i.e. the bookmark) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 12, Kelly teaches an apparatus for bookmarking an archived (i.e. stored) item of interest (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) comprising: a network server (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28); a database resident in said network server (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28), said database (i.e. the central database) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) containing information related to availability (i.e. *"Database 40 comprises information compiled from various sources, such as TV advertisements schedules 50 associated with various TV shows, TV show schedules 52, TV advertisers websites 62 and other websites topically related to broadcast content 64. AT 204 is then used to determine which data in the database 40 should be retrieved and presented to the viewer."*) of an item interest (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) stored on an archiving network (i.e. the internet that is used for archiving data) (Fig.1; col 2, lines 35-67; col 3, lines 1-28); a network interface) (Fig.1; col 2, lines 35-67; col 3, lines 1-28), said network interface

(Fig.1; col 2, lines 35-67; col 3, lines 1-28) contained in said network server (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) and providing interconnection (Fig.1; col 2, lines 35-67; col 3, lines 1-28) to the archiving network (i.e. the internet that is used for archiving data) (Fig.1; col 2, lines 35-67; col 3, lines 1-28); and a user input device (Fig.1; col 2, lines 35-67; col 3, lines 1-28), said user input device communicating with said network server (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) to provide identification information (i.e. *"activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory" ... "When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-line service 60 to a central database 40."*) (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) for the item of interest (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) and the viewer of the item of interest (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) wherein the viewer of the item of interest is viewing the item of interest on a medium (i.e. a browser or a TV) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) separate from a medium (i.e. they are stored in the broadcaster maintained storages e.g. websites where a website is essentially connected to a database or other forms of storage)

(Fig.1; col 2, lines 35-67; col 3, lines 1-28) that stores an archived version of the item of interest (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 16, Kelly teaches a method for bookmarking archived items of interest (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) comprising the steps of: receiving identification information (i.e. *"activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory" ... "When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-line service 60 to a central database 40."*) (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) for a broadcast program of interest at a network server (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28), said identification information including data related to the network on which said program was broadcast and data to determine a time of broadcast of said program (i.e. *"activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory" ... "When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-*

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line service 60 to a central database 40.") (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28); **determining an archival address for an archived version of said broadcast program** (i.e. the central database identifies the bookmark/URL of the TV event, which matches with the user provided identifying information) (Fig.1; col 2, lines 35-67; col 3, lines 1-28); and **bookmarking said archival address** (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 17, Kelly teaches that the step of bookmarking said archival address comprises the step of storing said archival address on a personal computer (i.e. "*Database 40 then generates a custom list of data for the user which indicates bookmarks associated with the broadcast event. For example this list of data could take the form, but not limited to, a World Wide Web (www) page on the internet.*"... "*network access device 21 such as a set-top box comprising a computer system coupled to a conventional TV tuner 34, or a specialized TV having computer processing capability (i.e. a PCTV), both having conventional network connection capabilities or other means for on-line access to the internet or other networks 60.*") (Examiner asserts that a user sitting at a PCTV can receive bookmark information/URL/archival address/or any other information related to the event from the network database server and bookmark the websites using a generic conventional web browser; the archival address/bookmark can be stored in a web page also to be viewed by the viewer) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 18, Kelly teaches step of bookmarking said archival address comprises the step of storing said archival address on a web page (i.e. "*Database 40 then generates a custom list of data for the user which indicates bookmarks associated with the broadcast event. For example this list of data could take the form, but not limited to, a World Wide Web (www) page on the internet.*"... "*network access device 21 such as a set-top box comprising a computer system coupled to a conventional TV tuner 34, or a specialized TV having computer processing capability (i.e. a PCTV), both having conventional network*

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connection capabilities or other means for on-line access to the internet or other networks 60.") (Examiner asserts that a user sitting at a PCTV can receive bookmark information/URL/archival address/or any other information related to the event from the network database server and bookmark the websites using a generic conventional web browser; the archival address/bookmark can be stored in a web page also to be viewed by the viewer) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

As to claim 21, Kelly teaches that the data to determine a time of broadcast of said program identifies a particular segment of said program (i.e. *"activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory" ... "When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-line service 60 to a central database 40."*) (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) and said archival address is associated with said particular segment of said program (i.e. the central database identifies the bookmark/URL of the TV event, which matches with the user provided identifying information) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (U.S. Patent No. 5,907,322 and Kelly hereinafter) in view of Jeff Peline ("The San Francisco Chronicle", January 18, 1996 and Peline hereinafter).

The teachings of Kelly have been discussed above.

As to claim 5, Kelly teaches the step of providing identification information (i.e. *"activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory" ... "When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-line service 60 to a central database 40."*) (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **for said item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **to said network server** (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

Kelly does not teach sending an electronic mail message to said network server.

Peline teaches sending an electronic mail message to said network server (i.e. a magic box/network computer which is analogous to a PC/laptop but with two-way pager, telephone, e-mail and other basic features) (page 1, lines 1-38).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Peline to include sending an electronic mail message to said network server with the motivation to use Oracle's \$500 network computer, which allows one to surf the internet, send e-mail and perform word processing (Peline, page 1, lines 2-3 and lines 13-14).

As to claim 19, Kelly teaches the step of receiving identification information (i.e. *"activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory" ... "When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-line service 60 to a central database 40."*) (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) for said broadcast program of interest (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) at said network server (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

Kelly does not teach receiving an electronic mail message at said network server.

Peline teaches receiving an electronic mail message at said network server (i.e. a magic box/network computer which is analogous to a PC/laptop but with two-way pager, telephone, e-mail and other basic features) (page 1, lines 1-38).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Peline to include receiving an electronic mail message at said network server with the motivation to use Oracle's \$500 network computer, which allows one to surf the internet, send e-mail and perform word processing (Peline, page 1, lines 2-3 and lines 13-14).

9. Claims 6,13,14,15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (U.S. Patent No. 5,907,322 and Kelly hereinafter) as discussed in the above rejections in view of Rob Guth ("Oracle unveils 'Internet Toaster' prototypes, SunWorld, march, 1996 and Guth hereinafter).

The teachings of Kelly have been discussed above.

As to claim 6, Kelly teaches step of providing identification information (i.e. "*activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory*" ... "*When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-line service 60 to a central database 40.*") (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **for said item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **to said network server** (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds

to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

Kelly does not teach orally communicating information to said network server.

Guth teaches orally communicating information to said network server (i.e. a magic box/network computer which is analogous to a PC/laptop but with two-way pager, telephone and other basic features communicates to a network server) (Guth, page 1, lines 7-15).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Guth to include orally communicating information to said network server with the motivation to use a low-cost network access device that would sell for less than \$500 (Guth, page 1, lines 3-4).

As to claim 13, Kelly does not teach that the user input device is a two-way pager.

Guth teaches that the user input device is a two-way pager (i.e. a magic box/network computer which is analogous to a PC/laptop but with two-way pager, telephone and other basic features) (Guth, page 1, lines 5-15).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Guth to include that the user input device is a two-way pager with the motivation to use a low-cost network access device that would sell for less than \$500 (Guth, page 1, lines 3-4).

As to claim 14, Kelly does not teach that the network server includes voice recognition software.

Guth teaches that the network server includes voice recognition software (i.e. a magic box/network computer which is analogous to a PC/laptop but with two-way pager, telephone and other basic features communicates to a network server) (Examiner asserts that the telephone is communicating to the network server; therefore for the network server to interpret the voice from the telephone, it needs to recognize the voice and hence must have a voice recognition software, and also numerous age old PCs come with voice recognition software) (Guth, page 1, lines 5-15).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Guth to include that the network server includes voice recognition software with the motivation to use a low-cost network access device that would sell for less than \$500 (Guth, page 1, lines 3-4).

As to claim 15, Kelly does not teach that the user input device is a telephone.

Guth teaches that the user input device is a telephone (i.e. a magic box/network computer which is analogous to a PC/laptop but with two-way pager, telephone and other basic features and communicates to a network) (Guth, page 1, lines 5-15).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Guth to include that the user input device is a telephone with the motivation to use a low-cost network access device that would sell for less than \$500 (Guth, page 1, lines 3-4).

As to claim 20, Kelly teaches step of receiving identification information (i.e. *"activity record (AR) entry comprises data describing the date, time, and channel is stored into an electronic memory" ... "When the viewer is ready to browse the websites associated with the selected broadcast events, either network access device 21, or personal computing device 20 of Fig.4, transmits activity table 204 comprising the AR entries and also viewer identifying data, such as particular demographic data, for example the postal code of the viewer's location, via on-line service 60 to a central database 40."*) (Examiner asserts that the viewer provides viewer identification information along with the TV event identifying information to the central database/database server on the network/internet) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **for said item of interest** (i.e. TV broadcast program e.g. a TV advertisement, a TV news broadcast, a TV educational or entertainment program) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) **at said network server** (i.e. the database on the network that provides/serves information related to the TV event to the viewer; a server is any computer or program (i.e. database) that responds to commands from a client. In other words, any software entity that serves a clients request) (Fig.1; col 2, lines 35-67; col 3, lines 1-28) (Fig.1; col 2, lines 35-67; col 3, lines 1-28).

Kelly does not teach orally communicating information to said network server.

Guth teaches orally communicating information to said network server (i.e. a magic box/network computer which is analogous to a PC/laptop but with two-way pager, telephone and other basic features communicates to a network server) (Guth, page 1, lines 7-15).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Guth to include orally communicating information to said network server with the motivation to use a low-cost network access device that would sell for less than \$500 (Guth, page 1, lines 3-4).

10. Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (U.S. Patent No. 5,907,322 and Kelly hereinafter) as discussed in the above rejections in view of Jakob Nielsen (U.S. Patent No. 5,890,164 and Nielsen hereinafter).

The teachings of Kelly have been discussed above.

As to claim 10, Kelly does not teach the step of determining whether said item of interest is archived on said second medium.

Nielsen teaches determining whether said item of interest (i.e. a file; A web TV show or a web page is also a file) (abstract; col 1, lines 30-42) **is archived** (i.e. *"the system monitors a large number of information sources such as pages on the World Wide Web, a user may not have time to normally look at each source at regular intervals"*) (Examiner asserts that the system looks for changes in the websites and therefore is able to detect a file (i.e. the item of interest) is archived/stored in the web sites) (Abstract; col 1, lines 30-42) **ON said second medium** (i.e. web sites) (abstract; col 1, lines 30-42).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Nielson to include determining whether said item of interest is archived on said second medium with the motivation to help a user monitor web pages because the user may not have time to normally look at each source at regular intervals (Nielson, Abstract, lines 1-3).

As to claim 22, Kelly does not teach the step of periodically accessing a database contained in said network server to determine when said broadcast program of interest has been archived.

Nielson teaches the step of periodically accessing a database contained in said network server (i.e. web sites/pages, which are stored in a database/file repository on the network/internet and the system monitors/accesses the database and therefore is able to determine when a new file (i.e. the broadcast TV show) is stored/archived in the database/file repository) (abstract; col 1, lines 52-60) to determine when said broadcast program of interest (i.e. the files/web pages etc.) (abstract; col 1, lines 52-60) has been archived (abstract; col 1, lines 52-60).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kelly with the teachings of Nielson to include periodically accessing a database contained in said network server to determine when said broadcast program of interest has been archived with the motivation to help a user monitor web pages because the user may not have time to normally look at each source at regular intervals (Nielson, abstract, lines 1-3).

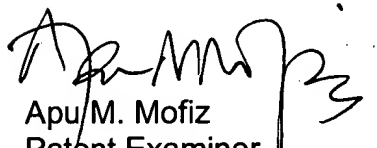
Points of Contact

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Apu M. Mofiz whose telephone number is (703) 605-4240. The examiner can normally be reached on Monday – Thursday 8:00 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached at (703) 305-3830. The fax numbers for the group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.



Apu M. Mofiz
Patent Examiner
Technology Center 2100

December 23, 2003